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PATENT 1/3/03 2800

Case Docket No. ASMMC.006AUS

Date: December 20, 2002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Raaijmakers et al.

Appl. No. : 09/452,844

Filed : December 3, 1999

For : CONFORMAL THIN FILMS  
OVER TEXTURED  
CAPACITOR ELECTRODES

Examiner : R. Rocchegiani

Group Art Unit : 2825

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) VA 22202, on

December 20, 2002

(Date)

*Adeel S. Akhtar*

Adeel S. Akhtar, Reg. No. 41,394

TRANSMITTAL LETTER

United States Patent and Trademark Office  
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Arlington, VA 22202  
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Dear Sir:

Enclosed for filing in the above-identified application are:

- (X) A Request for Reconsideration.
- (X) The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Account No. 11-1410.
- (X) Return prepaid postcard.

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Adeel S. Akhtar, Reg. No. 41,394
REQUEST FOR RECONSIDERATION

United States Patent and Trademark Office  
P.O. Box 2327  
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Dear Sir:

The present paper is submitted in response to the Final Office Action mailed on September 27, 2002, setting a three month period for response. Applicants respectfully request that the Examiner consider the remarks below, as they are believed to place the application in condition for allowance and do not require further search or extensive consideration.

The Examiner has maintained the rejection of all pending claims under 35 U.S.C. §103. Each of the rejections is based on the combination of Wu (5,650,351) and Suntola (4,058,430). In their prior response, Applicants argued that the rejection is improper because the Examiner has failed to show any motivation for the combination of high-k deposited by ALD over HSG silicon. In particular, Applicants argued that the general state of the art teaches away from such a combination.

In responding to Applicants' arguments, the Examiner states that "there is no requirement to show why a person with general skill in the art would choose one material versus another when both are disclosed in the main reference." Further, the Examiner indicates that because Wu discloses a high-k layer over HSG, "there does not need to be a showing of motivation to follow the disclosure because no modification is being made."

Applicants strongly disagree with the Examiners position and submit that the Examiner is legally incorrect. It is well established that when a rejection for obviousness depends on a combination of elements disclosed in prior art references, there must be motivation to combine those particular elements in the prior art *as a whole*. "There must be *evidence* that 'a skilled artisan, confronted with the same problems as the inventors and with no knowledge of the claimed invention, *would select the elements* from the cited prior art references for combination in the manner claimed.'" *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1998); see also *In re Werner Kotzab* 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

Further, it is impermissible to use the teachings of the present application to identify elements in the prior art for combination. One "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Dembiczak* 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Here, the Examiner is using the teachings of the present application to identify particular elements in the prior art, namely the combination of high-k and polysilicon. Moreover, the Examiner is *admittedly refusing to consider* the teachings of the art as a whole. "When determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art *as a whole* to suggest the desirability, and thus the obviousness of making the combination.'" *In re Beattie*, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992) (quoting *Lindemann*, 730 F.2d at 1462, 221 U.S.P.Q. at 488; emphasis added).

Applicants submit that the general requirement that the Examiner (1) show a suggestion to combine elements and (2) consider teachings away from the combination apply even when two of three combined elements come from the same reference. The fact that the Examiner is picking and choosing elements from within one reference does not change the fact that the Examiner is picking and choosing in hindsight.

Applicants submit that *Ecolochem, Inc. v. Southern California Edison Co.* controls the present issue. In that case, the Federal Circuit found that even if a primary reference discloses a particular aspect of the claimed invention, in making an obviousness rejection it is still necessary to consider whether one of skill in the art would have chosen that disclosure in view of other teachings in the art. The court found that “The evidence available, however, indicates that even if one of ordinary skill in the art had been given the Houghton reference, they would not have been inclined to use it, due to the large amount of teaching away...” 227 F.3d 1361, 1375 (Fed. Cir. 2000). Similarly, in the present case one ordinary skill in the art would not have chosen the disclosure in the Wu reference because the art as a whole teaches away from the combination of high-k and polysilicon.

The Examiner appears to believe that the obviousness inquiry is ended by a mere technical finding of any reason to combine two *references*. However, Applicants remind the Examiner that the ultimate issue in obviousness is whether “a skilled artisan, confronted with the same problems as the inventors and with no knowledge of the claimed invention would select the *elements* from the cited prior art references for the combination in the manner claimed.” *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1998). Applicants submit that the Examiner cannot circumvent the requirement of showing a suggestion to combine by willfully ignoring all of the teachings away from the combination in the prior art, and picking and choosing disclosure from within any given reference with no consideration to how the skilled artisan would have felt about that disclosure at the time of the invention. The fact that the rejections are based on 35 U.S.C. § 103(a) means that the Examiner *must* consider all of the evidence teaching away from the combination as a whole. “The secondary considerations are . . . essential components of the obviousness determination.” *In re Rouffet* 149 F.3d 1350, 1355, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998). Certainly the skilled artisan would not have selected the particular teachings from Wu that the Examiner has elected, in hindsight, to use in the combination with Suntola.

In summary, Applicants submit that it is *legal error* for the Examiner to refuse to consider teachings away from the asserted combination on the grounds that two elements within the combination happen to be taught in one reference. Contrary to the Examiner’s position, the suggestion that the Examiner must show is not for the combination of Wu with Suntola, but is

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rather for the combination of the elements selected. With this realization, it would be clear that the art as a whole taught against the selected combination prior to Applicants' invention.

As the Examiner has not provided any motivation to combine the selected elements, and the art as a whole teaches away from such a combination, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103 and issuance of a Notice of Allowance. If any issues remain, the Examiner is invited to telephone Applicants' counsel at the number listed below in order to resolve such issues promptly.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: December 20, 2002

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